

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**APPLICANT:** Steven F. LIVENGOOD      **GROUP:** 2625  
**APPLICATION:** 10/802,213      **EXAMINER:** I. Cruz  
**FILED:** March 17, 2004      **CONFIRMATION:** 3559  
**FOR:** **USER-ADJUSTIBLE MECHANISM FOR EXTRACTING FULL COLOR  
INFORMATION FROM TWO-COLOR INK DEFINITIONS**

Honorable Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**PETITION TO INVOKE THE COMMISSIONER'S SUPERVISORY AUTHORITY**  
**UNDER 37 C.F.R. 1.181**

The Applicants respectfully request the Honorable Commissioner of Patents to invoke the Honorable Commissioner's supervisory authority under 37 C.F.R. 1.181 and require the Examiner to withdraw the requirement for restriction and to continue the timely examination of all pending claims 1 – 19, with respect to the above-identified application.

**STATEMENT OF FACTS**

1. In the first Office Action, dated December 11, 2007, the Examiner examined all claims pending in the application, claims 1 - 19. The Office action included rejections based upon 35 USC §112, second paragraph as well as 35 USC §102(b) and 103(a).

2. In a Response to the first Office Action, dated March 11, 2008, the Applicants responded to the rejections, including amendments to independent claims 1 and 6.

3. In the second Office Action, dated June 24, 2008, the Examiner again examined all claims (1 – 19) pending in the application. The Office action included a response to Applicants arguments, and new grounds for rejection of the claims based upon 35 USC §103(a).

4. In a Response to the second Office Action, dated September 24, 2008, the Applicants responded to the rejections, including amendments to independent claims 1 and 15.

5. In the third Office Action, dated December 26, 2008, the Examiner again examined claims 1 – 19 pending in the application. The Office action again set forth new grounds for rejection of the claims based upon 35 USC §103(a).

6. In a Response to the third Office Action, dated March 26, 2009, the Applicants again responded to the rejections, including amendment to independent claims 6.

7. In the fourth Office Action, dated June 24, 2009, the Examiner (apparently with the approval of SPE K. Y. Poon) has withdrawn all prior rejections in favor of an

Election of Species Requirement alleging a plurality of species to be present and mutually exclusive.

### **DISCUSSION**

In the fourth Office Action, dated June 24, 2009, the Examiner subjected claims 1-19 to an Election of Species Requirement.

In formulating this Election of Species Requirement, the Examiner alleged three distinct species: Species I – pertaining to a method for converting input data representing a color formed from only two primary colors to output data representing a color in a full-color space; Species II - pertaining to a method for converting input data representing a color formed from only two primary colors to output data representing a color formed from at least three colors; and Species III - pertaining to a method of instructing a printing system which prints in at least three colorants to print a predetermined color defined using only a first and second color. The Examiner further asserts for the first time, in the fourth Office Action, dated June 24, 2009, that these species are independent and distinct.

The Examiner is respectfully reminded that, pursuant to **MPEP** §809.02(a)

“The species are preferably identified as the species of figures 1, 2, and 3 or the species of examples I, II, and III, respectively. In the absence of distinct figures or examples to identify the several species, **the mechanical means, the particular material, or other distinguishing characteristic of the species should be stated for each species identified.**” (emphasis added)

As noted in the concurrently-filed response, the mere identification of the alleged species does not meet the requirements to establish a proper Election of Species Requirement. Not only must the Examiner clearly identify the alleged species, the Examiner must also demonstrate that the alleged species are independent or distinct. (**MPEP** §808.02) More specifically, **MPEP** §808.02 sets forth that criteria of **MPEP** §806.05(c) - §806.06 must be met.

In the fourth Office Action, the Examiner fails to demonstrate how the alleged species are patentably independent or distinct using the criteria of **MPEP** §806.05(c) - §806.06.

Furthermore, **MPEP** §808.02 sets forth, “[w]here the \* inventions as claimed are shown to be independent or distinct under the criteria of **MPEP** §806.05(c) - §806.06, the examiner, in order to establish reasons for insisting upon restriction,

must explain why there would be a serious burden on the examiner if restriction is not required.” **MPEP** §808.02 sets forth that the Examiner must show that the claimed inventions would have a separate classification; that the claimed invention have separate status in the art; or that the claimed invention have separate different fields of search.

In the fourth Office Action, after having examined all claims on the merits for three prior Office Actions, the Examiner now alleges an examination and search burden. Applicants respectfully contend that such a position is entirely contrary to the prior prosecution of this application, and for that reason alone the Examiner fails to establish reasons for insisting upon restriction.

Therefore, for all the foregoing reasons, the Examiner failed to demonstrate a proper basis for an Election of Species Requirement with respect to the three alleged species.

Accordingly, the Applicant respectfully requests the Honorable Commissioner of Patents to require the Examiner to examine claims 1 - 19 with respect to the above-identified application.

#### **RELIEF FROM FURTHER ELECTION OF SPECIES REQUIREMENTS**

The Applicant respectfully requests that the Examiner refrain from issuing any further restriction or election of species requirements and to immediately examine and/or allow the claims in the above-identified application.

To date, the Examiner has issued four Office Actions where, in the first three actions, the Examiner set forth various grounds for rejection. Moreover, as is clear from the record, the Examiner failed to establish a *prima facie* case to support either an election of species or restriction requirement in this fourth Office Action. Moreover, the Examiner has thrice examined **ALL** of the presently pending claims on their merits. Thus, the Examiner has no justification to subject the pending claims to an Election of Species or Restriction Requirement.

It is noted that the current Office Action has caused the Applicant to incur unnecessary costs to address a non-sustainable position by the Examiner. In

addition to these costs, the Examiner has unjustly delayed the prosecution of this application.

It is Applicants' position that the Applicants should not have to incur such costs in addressing an untenable attempt to establish an Election of Species or Restriction Requirement.

**MPEP §811 sets forth, "[b]efore making a restriction requirement after the first action on the merits, the examiner will consider whether there will be a serious burden if restriction is not required." Not only is the Examiner asserting a restriction requirement after the first action on the merits, the Examiner is asserting a restriction requirement after three substantial examinations and Office Actions on the merits. What burden is being placed upon the Examiner, at this time in the prosecution of the above-identified application, which did not manifest itself during the prior examinations and Office Actions on the merits ?**

It is apparent from the record that the Examiner failed to consider whether there will be a serious burden if restriction is not required. Moreover, as set forth above, the Examiner failed to demonstrate any burden by which to justify an Election of Species requirement, notwithstanding its timing within the prosecution timeline for the above-identified application. Since it is clear that the Examiner failed to consider whether there will be a serious burden if restriction is not required, subjecting the currently pending claims 1- 19 to an Election of Species Requirement, after three substantive examinations and Office Actions on the merits, is respectfully urged to be arbitrary and capricious.

Therefore, it is the Applicants' position that the Applicants should receive a Notice of Allowance without further delay.

In summary, in view of the failure to establish an Election of Species Requirement, and the Applicants' meeting of their obligation to make an election, the Applicants respectfully request that the Honorable Commissioner of Patents to require the Examiner to withdraw the requirement and to refrain from issuing any further Restriction or Election of Species Requirements, and to immediately issue an appropriate Notice of Allowance.

**Conclusion**

In view of the discussion set forth above, Applicants respectfully petition the Honorable Commissioner of Patents to require the Examiner to examine claims 1 - 19 with respect to the above-identified application. Moreover, the Applicants respectfully petition the Honorable Commissioner of Patents to require the Examiner to refrain from issuing any further Restriction or Election of Species Requirements and to immediately issue an appropriate Notice of Allowance. Also, an early indication of allowability is earnestly solicited.

Respectfully submitted,

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